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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Akihiro Tanaka

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EXAMINER

KHAN, ASHER R

ART UNIT

PAPER NUMBER

2621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/578,913		TANAKA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	ASHER KHAN		2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/26/2009;06/29/2006;05/09/2006</u> .                        | 6) <input type="checkbox"/> Other: _____.                         |



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim 1-6, 7-9, 11-15, and 17-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,113,983 B1 to Terada et al “Terada”.**

As to claims 1, 19, 21 and 23, Terada discloses content reproduction device which reproduces a stream media content linked from a multimedia content, said device comprising:

a display unit operable to display the multimedia content (Program; Figs. 3 and 5; Col. 3 lines 10-20);

a reproducing unit operable to reproduce the stream media content (Content; Col. 3, lines 2-20);

a reproduction state change accepting unit operable to accept, from a user, reproduction state change information indicating a change in a reproduction state of the stream media content (Col. 3, lines 51-55; reproduction change to fast forward or rewind of a content being currently reproduced); and

a return position determining unit operable to determine, according to the reproduction

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state change information accepted by said reproduction state change accepting unit (Change from normal reproduction to Fast forward or Fast rewind), a return position (URL for the content) in the multimedia content for a transition after the reproduction of the stream media content is ended (client device acquires another content that precedes or follows and reproduces contents and ends reproduction of currently reproduced by fast forwarding or reversing), wherein said display unit is operable to display the multimedia content located in the determined return position (Figs. 3, 6a-6c; Col. 3, lines 50-67; Col. 4, lines 1-3; Col. 11 lines 31-52).

As to claims 2, 20 and 22, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein said return position determining unit is operable to obtain a transition condition table (program file, Fig. 3) describing a relationship between the reproduction state (preceding or following contents are being fast forwarded or fast rewound or currently played) and the return position (content URL), and to determine the return position (content URL) based on the transition condition table and the reproduction state change information (Fig. 3; Col. 12, line 47-60).

As to claim 3, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses comprising a storing unit in which the multimedia content (Fig. 3, program file with contents), the stream media content (Fig. 3, contents) and the transition condition table (Program file) are stored, wherein said reproducing unit is operable to reproduce the stored stream media content, said display unit is operable to display the stored multimedia content, and said return position determining unit is

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operable to determine the return position based on the stored transition condition table and the stored reproduction state change information (Figs. 3;Col. 3, lines 50-67;Col. 4, lines 1-3).

As to claim 4, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, further comprising a receiving unit operable to receive, from a server via a network (Fig. 1), the multimedia content, the stream media content and the transition condition table, wherein said reproducing unit is operable to reproduce the received stream media content, said display unit (Fig. 5) is operable to display the received multimedia content, and said return position determining unit is operable to determine the return position based on the received transition condition table and the received reproduction state change information (Figs. 3;Col. 3, lines 50-67;Col. 4, lines 1-3).

As to claim 5, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the return position is at least two different URLs (Figs. 3 and 8).

As to claim 6, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, wherein the reproduction state change information includes at least one of, stop or fast-forward, or rewind as a change in the reproduction state (Col. 3 lines 50-67; Col. 16 lines 49-67 and col. 17 lines 1-2), and time information indicating time when the change is made in the reproduction state (Fig. 8, reproduction timing), and said return position determining unit is operable to determine, with reference to the reproduction state which corresponds to the time information, the return

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position based on whether or not a transition condition described in the transition condition table is satisfied (Col. 3 line 50-67).

As to claim 8, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein at least a first content and a second content are included in the multimedia content to be displayed after the reproduction of the stream media content is ended, and said display unit is operable (a) to display the first content in the case where the reproduction information change information (execution of fast forward or fast reverse) is accepted until the reproduction of the stream media content is ended, and (b) to display the second content in the case where the reproduction information change information is not accepted until the reproduction of the stream media content is ended (Col. 3 line 40-67 and Col. 1-3, following it true when Program file (Multi media content) includes currently played (second content) and preceding or following contents (first content) until the execution of fast forward or fast reverse).

As to claim 9, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein said display unit is operable (a) to display the first content (preceding or following content) in the case where the reproduction information change information includes one of fast-forward and stop, and (b) to display the second content (currently played content) in the case where the reproduction information change information includes neither of fast-forward and stop (Col. 3 line 40-67 and Col. 1-3).

As to claim 11, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses further comprising a reading unit operable to read, via a

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storage medium (cache), at least one of the stream media content (content), the multimedia content (program), and the transition condition table (program file) (Figs. 1 and 3).

As to claim 12, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein upon receiving the reproduction state change information (reproduction change to fast forward or reverse) from said reproduction state change accepting unit and changing the reproduction state, said reproducing unit is operable to notify said return position determining unit of the reproduction state change information, and after the reproduction of the stream media content is ended, , said return position determining unit is operable to determine the return position based on the reproduction state change information (Col. 3, line 49-67; reproduction of preceding or following content after ending reproduction of currently reproduced content).

As to claim 13, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein said return position determining unit holds a state which changes each time the reproduction state change information is received from said reproducing unit, and is operable to determine the return position based on the state after the reproduction of the stream media content is ended, and said display unit is operable to display the multimedia content located in the return position (each time program file is changed new content with their corresponding URL are provided; Col. 2 line 43-67 and Col. 3 line 1 -20).



As to claim 14, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein said display unit holds a state (reproduction of contents currently reproduced and following contents if a fast forward command is issued) which changes each time the reproduction state change information (fast forward or fast reverse command) is received from said reproducing unit, and after the reproduction of the stream media content is ended, said display unit is operable to determine the return position according to the state and notify said return position determining unit of the return position (reproduction of following program instead of currently reproduced; Col. 12, lines 46-63; Figs. 6b and 6c).

As to claim 15, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein said reproducing unit holds a state which changes each time the state of reproducing the stream media content is changed (fast forwarding of currently reproduced contents and reproduction of following contents), and is operable, after the reproduction of the stream media content is ended, to determine the return position according to the state (if fast forward reproduce following contents), and to notify said return position determining unit of the return position (URL of following contents)(Col. 12, lines 46-63; Figs. 6b and 6c).

As to claim 17, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein said return position determining unit is operable to (a) determine a screen for exempting charging, as the return position of the multimedia content, in the case where the reproduction state change information is not found until the reproduction of the stream media content is ended, and determine a screen for

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charging, as the return position of the multimedia content, in the case where the reproduction information change information is found until the reproduction of the stream media content is ended (Fig. 5, shows screen for purchasing contents and delivering of the contents purchased).

As to claim 18, Terada discloses server apparatus which distributes a multimedia content (Program) and a stream media content (contents) to a content reproduction device, said server comprising :

a table generating unit operable to generate a transition condition table (program file) describing a relationship between a reproduction state (preceding or following contents are being fast forwarded or fast rewound or currently played; Fig. 3) of the stream media content in the content reproduction device, and a transit destination (URL) in the multimedia content in accordance with the reproduction state (normal reproduction or Fast forward or rewind) (Col 3. line 20-30; Col. 12, line 47-60).; and a transmitting unit operable to transmit the transition condition table (program file) to the content reproduction device (Fig. 1 communication network; Col 3. line 20-30).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,113,983 B1 to Terada et al “Terada” in view of Official notice.**

As to claim 7, Terada discloses everything claimed as applied in claim 1 above. But Terada does not expressly disclose wherein said return position determining unit is operable to determine, as the return position, a default return position which is previously determined in the case where the return position corresponding to the reproduction state change information is not described in the transition condition table. However official notice is taken of the fact that it would have been obvious to one skill in the art to provide a default value for a return position when it is not described in the transition condition table. It is very well known in the art to provide default values if some values are not input or not present. Therefore it would have been obvious to one skilled in the art at the time of invention to have been motivated to have a default value incase of the return position is not described.

**5. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,113,983 B1 to Terada et al “Terada” in view of U.S. Patent 5,956,037 to Osawa et al. “Osawa”**

As to claim 10, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses the ending of reproduction of multi media content and a return position determining unit to determine the return position (Figs. 6a-6c) .But Terada does not expressly, further comprising a reproduction history storing unit which holds a history of the reproduction state change information, wherein upon receiving the reproduction state change information from said reproduction state change accepting

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unit and changing the reproduction state, said reproducing unit is operable to notify said reproduction history storing unit of the reproduction state change information, and to read the history of the reproduction state change information held in said reproduction history storing unit.

Osawa further discloses comprising a reproduction history storing unit which holds a history of the reproduction state change information (Fig. 1b; col. 2 line 26-29), wherein upon receiving the reproduction state change information from said reproduction state change accepting unit (Fig. 6, 601) and changing the reproduction state, said reproducing unit is operable to notify said reproduction history storing unit of the reproduction state change information, and to read the history of the reproduction state change information held in said reproduction history storing unit (Col. 12 lines 35-55; Col. 13 lines 27-42; Fig. 6).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Terada with the teachings of Osawa. Motivation to combine would have been to provide a history of contents so that appropriate return position of contents can be achieved so that the appropriate contents according to the return position could be played.

As to claim 16, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, wherein, after the reproduction of the stream media content is ended(client device acquires another content that precedes or follows currently reproduced contents if a fast forward command is issued by a user), one of said display unit and said reproducing unit is operable to read the state (display unit and

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reproducing unit reproduces and for example fast forwards) and, to determine the return position, and to notify said return position determining unit of the return position (Col. 12, lines 47-61). However Terada does not expressly disclose a history of the reproduction state change information held in said reproduction history storing unit.

Osawa discloses a history of the reproduction state change information held in said reproduction history storing unit (fig. 1B, 105' or Fig. 6)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Terada with the teachings of Osawa. Motivation to combine would have been providing a unit that holds history of operation performed by a user so that an appropriate location of reproduction could be determined.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2621

/A. K./  
Examiner, Art Unit 2621